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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,209	01/14/2004	Samer Kabbani	COHU1180	4869
25548	7590	08/04/2005	EXAMINER	
DLA PIPER RUDNICK GRAY CARY US, LLP			KARLSEN, ERNEST F	
4365 EXECUTIVE DRIVE, SUITE 1100			ART UNIT	
SAN DIEGO, CA 92121-2133			PAPER NUMBER	
			2829	

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,209

Applicant(s)

KABBANI ET AL.

Examiner

Ernest F. Karlsen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 12-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 0104 0504 0605.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Applicants' election with traverse of Invention II, claims 6-11, in the reply filed on April 18, 2005 is acknowledged. The traversal is on the ground(s) that the restriction does not set forth any basis for restricting Invention II from Invention III. This is not found persuasive because Applicants have not shown that Inventions II and III are not patentably distinct. In addition, MPEP Section 806.05(h) requires only that the product as claimed can be used in a materially different process of using that product. The obvious method of using the apparatus of Invention I is something different from the method of claim 12. Inventions I, II and IV are product and Invention III is process of use.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-5 and 12-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions and or/species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 18, 2005.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this

title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeHaven et al in view of Burward-Hoy. With regard to claim 6, DeHaven et al show, in Figure 7, a plurality of active temperature control devices (the four units as described in columns 9 and 10) wherein the temperature, hot and cold, is controlled as explained with regard to Figures 5, 6 and 7. The apparatus has a thermal transfer surface 12, Figure 6, and the temperature is controlled for each device under test. DeHaven et al do not show a fluid cooled heat sink thermally coupled to a thermal transfer surface. Burward-Hoy show a heat exchanger with wherein flow rate of a fluid is controlled to control temperature in the heat exchanger and the heat exchanger is coupled to a thermal transfer surface as shown in Figures 3 and 4A. It would have been obvious to one of ordinary skill in the art at the time of the invention to have adapted the heat exchange technique of Burward-Hoy to the apparatus of DeHaven et al because one skilled in the art would realize that such would result in more accurate and faster control of temperature. With regard to claims 7, 8, 9

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and 11, the added limitations are considered inherent in the apparatus resulting from the combination of DeHaven et al and Burward-Hoy. With regard to claim 10, Burward-Hoy describes a resistive reactive heater at column 3, lines 17 plus and Figure 13 shows an inductive heater.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Furuya et al, Shirley, Jones, Kenny Jr. et al, Gaasch et al, Hamada and Malinoski et al all show control of flow rate of a fluid used to control the temperature of a device under test.

Any inquiry concerning this communication should be directed to Ernest F. Karlsen at telephone number 571-272-1961.

Ernest F. Karlsen

August 2, 2005


ERNEST KARLSEN
PRIMARY EXAMINER